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Remarks

Before proceeding with detailed discussion of the amendment as filed in response to the outstanding Office Action, the Applicant would like to raise three formal issues.

The Office Action summary fails to acknowledge receipt of the claim for foreign priority. A certified copy of the priority document should have been received in this national stage application from the PCT International Bureau. The Applicant respectfully requests confirmation thereof in the next Office Action.

The Examiner has pointed out that the Information Disclosure Statement fails to comply with 37 CFR 1.98(a)(2) since all references are not present in the application or have not been filed. The Applicant respectfully disagrees, since the instant application is the national stage of PCT/EP99/08592. In accordance with MPEP 1893.03(g) copies of the PCT search document and the cited prior art should have been forwarded to the USPTO by the European Patent Office and should be present in the international portion of the file wrapper. Inspection thereof, entry of the former references not considered in the Information Disclosure Statement and examination of those references is therefore respectfully requested.

The Examiner has pointed out that the numbering of the claims is not in accordance with 37 CFR 1.126 which requires that the original numbering of the claims be preserved throughout the prosecution. The Examiner has renumbered claims 25 through 52 as 26 through 53. The

Applicant respectfully accepts this renumbering and will use the renumbered claims as indicated by the Examiner. However, the Applicant would like to point out to the Examiner that the actual numbering of the claims was correct. This is the case, since the instant application is the national stage of a PCT application. The original application had 25 claims but in the amendment annexed to the International Preliminary Examination Report, new claims 1 through 24 were substituted. In entering the national stage, the Applicant submitted a preliminary amendment and explicitly indicated that that preliminary amendment was based on the application as amended in the PCT stage. A translation of the annexes of the International Preliminary Examination Report was filed with the national stage request. Therefore, the numbering was correct. However, in order to prevent further confusion concerning this point, the Applicant proposes maintaining the new numbering of former claims 25 through 52 as new claims 26 through 53. Claim 25 has been cancelled.

The Examiner has objected claim 43 due to a misspelling in line 5 thereof. This misspelling has been corrected through introduction of the word --thermoplastic--.

Claims 25, 27 through 31, 49 and 50 stand rejected under 35 USC 112 second paragraph as being indefinite. With regard to claim 25 that claim has been cancelled. With regard to claims 27 and 29 through 31 the Examiner points out that it is unclear whether or not the claims are opened or closed, since the independent claim states that the carrier consists essentially of the material, while the dependent claims indicate that the carrier comprises the material. In addressing this objection, the

Applicant has amended independent claim 26 to replace the language "consisting essentially of" with --comprising-- thereby causing the claim to become open and thereby obviating the problem with respect to claim 27. With regard to claim 28 the word "contains" has been replaced with --comprises--.

The Examiner has rejected claims 27 and 29 since the language "a natural polymer on the basis of lignin" is unclear. In addressing this rejection, the Applicant has changed the language to recite --a natural polymer based on lignin--. Regarding claim 49 the Examiner has pointed out that it is unclear if the several decorative layers claimed are the plurality of decorative layers of claim 43 and has also objected the word "different". In addressing this objection, the Applicant has amended claim 49 to recite --said plurality of decorative layers-- and has deleted the word "different". Regarding claim 50, the Examiner has pointed out that it is unclear whether or not the fiber layer is between the decorative layer and the carrier or if the decorative layer is between the fiber layer and the carrier. This problem has been solved in the amended claim 50, specifying that the fiber layer is between the decorative layer and the carrier.

Claims 26, 27, 30 through 32, 37 through 49 and 51 through 53 stand rejected under 35 USC 103(a) as being unpatentable over Hartzell (US patent 1,945,754) in view of Rettenbacher et. al. (US patent 5,939,192) and Jaschke et. al. (US patent 4,205,107). Claims 34 through 36 and 50 stand rejected under 35 USC 103(a) as being unpatentable over Hartzell, Rettenbacher and Jaschke as applied to claims 26 and 43 above in further view of Valle (DE 3012910a1). Claims

37 through 42 stand rejected under 35 USC 103(a) as being unpatentable over Hartzell, Rettenbacher et. al. and Jaschke as applied to claim 26 above in further view of Ogata (US patent 4,911,969).

The Examiner has however indicated that claim 33 is objected to as being dependent upon a rejected base claim but would otherwise be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and that claims 28 and 29 would also be allowable if rewritten to overcome the rejections under 35 USC 112 second paragraph and to include the limitations of the base claim and any intervening claims.

In addressing these rejections, the Applicant has amended independent claims 26 and 43 to specify that the decorative layers are bonded to the carrier without the use of glue. The glue-free connection of the instant invention is disclosed on page 2 of the specification, second and third lines from the bottom.

The Hartzell and Jaschke references are used to disclose forming a composite body by pressing overlapping layers of material into a substrate. However, both the Hartzell as well as the Jaschke references teach away from the instant invention as claimed, since they explicitly require the use of an adhesive to attach the layer(s) to the substrate (Hartzell reference symbol 14. Jaschke claim 1 lines 8 and 9 and column 1 lines 56 through 58). The invention as now claimed permits a composite structure in which only the uppermost decorative layer(s) must be precisely shaped since irregularities and uneven edges in the underlying layer(s) are covered by the upper layer(s). Moreover, the

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elimination of glue prevents uneven portions of the glue layer from negatively effecting the overall flatness and appearance of the surface. In addition, the composite material in accordance with the invention is less expensive and simpler to produce, since the processing step of gluing is eliminated. Seen in this manner, the avoidance of glue in the instant invention as now claimed leads to advantages over the prior art in view of features from which that prior art teaches away. The invention as claimed is therefore sufficiently distinguished from the prior art of record to satisfy the conditions for patenting in the United States. Passage to issuance is therefore respectfully requested.

No new matter has been added in this amendment.

Respectfully submitted,



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